

REMARKS

This is in response to the Office Action mailed on October 29, 2003, and the references cited therewith.

No claims are amended, canceled, or added; as a result, claims 1-2, 4-5, 7-22 and 26-32 remain pending in this application.

§103 Rejection of the Claims

Claims 1-2, 4-5, 7-22 and 26-32 were rejected under 35 USC § 103(a) as being unpatentable over Kim (US 6,147,682) in view of Antos (US 5,790,201). In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). Applicant respectfully traverses the rejection because no proper motivation to combine the cited references has been provided.

The Office Action fails to provide, in the form of specific and objective evidence of record, a proper motivation to combine Kim and Antos. The Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). The Office Action's only statement of a motivation to combine Kim and Antos are "because it eliminates cable and enable [sic] more flexible use of the input device" This is a mere conclusory statement of subjective belief of the type specifically rejected in *Lee*. Further, no reasoning as to why specific and objective evidence of record supports the finding has been provided. Therefore Applicant respectfully submits that the Office Action has not provided objective evidence for a

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suggestion or motivation to combine the references. As a result, a prima facie case of obviousness does not exist with respect to the claims.

Additionally, a factor cutting against a finding of motivation to combine or modify the prior art is when the prior art teaches away from the claimed combination. A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path the applicant took. *In re Gurley*, 27 F.3d 551, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994); *United States v. Adams* 383 U. S. 39, 52, 148 USPQ 479, 484 (1966); *In re Spinnoble* 405 F.2d 578, 587, 160 USPQ 237, 244 (C. A. 1969); *In re Caldwell* 319 F. 254 256, 138 USPQ 243, 245 (C. A. 1963).

As discussed in the responses submitted November 14, 2002 and July 24, 2003, Antos teaches away from the proposed combination. Antos expressly states that its keyboard **"preferably includes an integral mouse 30 and an integral joystick 32** electrically coupled thereto as shown (see Antos at column 3, lines 27, emphasis added). Figure 1 of Antos shows the peripherals directly connected to the keyboard 14, and does not teach any use of connectors according to the present invention. Thus, the use of integral connections in Antos teaches away from the use of removable connectors for connecting peripherals. As a result, the combination of Antos and Kim is improper because Antos teaches away from their combination.

For all of the above reasons, Applicant respectfully submits that there is no motivation to combine Kim and Antos. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1-2, 4-5, 7-22 and 26-32.

Additionally, with respect to claims 21, 22 and 28, the Office Action admits that neither Kim nor Antos teach sending a single signal to the main computer. However, the Office Action appears to take official notice stating, "the concept and advantages of multiplexing signals from a plurality of devices onto a single signal for wireless transmission is old and well known in the art." In the Office Action Response date July 24, 2003, Applicant timely objected to the apparent official notice. Applicant again respectfully traverses this official notice and requests the Examiner to provide a reference that describes such functionality, and further such functionality with respect to USB data. Absent a reference, it appears that the Examiner is using

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personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. 1.104(d)(2).

Additionally, Applicant again notes that Antos teaches away from sending a single signal. FIG. 1 of Antos and the accompanying descriptive text at column 3, lines 39-54 clearly shows separate signals 35, 36 and 38 being sent for each of the mouse, keyboard and joystick.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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Date Apr. 29, 2004

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Certificate Under 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, and addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 29th day of April, 2004.

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